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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Arjan Claassen

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,863	<b>Applicant(s)</b> CLAASSEN ET AL.	
	<b>Examiner</b> AMEE A. SHAH	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 32-60 are pending in this action.

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report relating to foreign patents and publications have not been considered.

Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

The references relating to US patents and publications cited in the Search Report dated June 10, 2005, issued by the European Patent Office, have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 3, 4, 5, 6, 7 and 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

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accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The use of the trademark BLUETOOTH has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

Claims 52-60 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 52 is written as an independent claim, but depends from claim 41. Because claims 53-60 are dependencies of claim 52, they inherit the same deficiencies and are objected to for the same reasons.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 32-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In particular, it is not clear to one of ordinary skill in the art what is meant by the limitations of claims 32, 41 and 52 of "presenting an offer accept to said second bartering party" and "receiving an offer accept originating from said second bartering party." Is any offer to be accepted presented to the second bartering party, is an offer acceptance presented or is the replacing offer presented? Is an offer acceptance received from the second bartering party or is another offer to accept originating from the second bartering party received? For purposes of this action only, the examiner will interpret the limitations as presenting any offer to be accepted to the second bartering party and receiving an offer acceptance originating from the second bartering party. Because claims 33-60 are dependencies of claim 32, they inherit the same deficiencies, are rejected on the same basis and are interpreted in the same manner.

Claim 33 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 33 recites the limitation "and/or based on preference data." It is not clear whether basing on preference data is required, i.e. the metes and bounds of the claim are unclear. For purposes of this action only, the examiner will interpret the limitation in the alternative, i.e. or based on preference data, such that basing on preference data is not required.

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Claim 39 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 39 recites the limitation "wherein said step of presenting an offer to said second bartering party comprises..." in lines 1 and 2 of the claim. It is not clear to one of ordinary skill in the art to which step of presenting an offer this refers as there are two such steps in claim 32. Does claim 39 seek to further limit the step of claim 32 of presenting the first offer to the second party (lines 13-14) or the step of presenting any offer to be accepted to the second party (lines 25-26)? For purposes of this action only, the examiner will interpret claim 39 as further limiting the step of presenting the first offer, as indicated in claim 39.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of claim 40 is unclear as it depends on "Digital Rights Management regulations." First, it is not clear to which regulations the claim refers, i.e. is there a specific act/law in a certain country or universal. Second, even if the specific regulation is known, regulations are always changing, and thus the scope of the claim would always change and be unknown. For purposes of this action only, the examiner will interpret the claim as accessing items in accordance with any type of regulation.

Claims 41-53, 55 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim elements "obtain and store," "receive and store," "compute," "send," "process," "receive," and "compare" are means (or step) plus function

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limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.



***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 41-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 41 is directed to an apparatus comprising data and means and no hardware or structures. The means can all be software; thus, claim 41 comprises an apparatus comprising solely of data and software, i.e. descriptive material. Software and data, per se, are not statutory because they are not capable of causing a functional change in a computer. The data structures, i.e. software and data, do not define any structural and functional interrelationships between the data structure and other claims aspects of the invention which permit the data structures' functionality to be realized. See MPEP §2106.01 [R-6]. Because claims 42-51 are dependencies of claim 41 and do not recite any further hardware or structure, they inherit the same deficiencies of claim 41 and are rejected on the same bases.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 32, 35, 39, 41, 44, 48 and 50-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore, US 6,847,938 B1 (hereafter referred to as "Moore").**

Referring to claim 32, Moore discloses a method for automatic bartering for items, between at least a first and a second bartering party, at a programmable device (100) (e.g. Abstract and Figs. 2-5), comprising the steps of:

- creating a first set of preference data (120), that values items in accordance with input data originating from said first bartering party (col. 4, lines 26-28 and col. 6, lines 30-67 – note the preference data include the information about the item being offered for exchange and item desired to be received in exchange and the first bartering party is Party 1);
- receiving (1) a second set of preference data (220), that values items in accordance with input data originating from said second bartering party (col. 4, lines 12-28 and col. 6, lines 30-67 - note the preference data include the information about the item being offered for exchange and item desired to be received in exchange and the second bartering party is Party 2);
- computing (2) a first offer (130) based at least on said first and second sets of preference data and on items (110) available to said first party for bartering at said device (col. 7, lines 18-35 and col. 8, line 36 through col. 9, line 9 and lines 41-50– note the first offer is the match or alternative match);
- presenting (3) said first offer to said second bartering party (col. 9, lines 19-50);
- receiving (3) data representing a second offer (230) related to said second bartering party (col. 10, lines 61-66 – note the second offer is the third party offer of items to exchange);

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- processing (4) said received offer by comparing offered items, contained in said received offer, at least to items accessible to said first bartering party (110), to said offer (120) computed by said first device (100) or to data originating from said first bartering party, stating which items that are to be rejected (col. 10, lines 32-66 – note the processing is comparing the items in the second offer to data originating from said first party);
- rejecting (5) one or several of said offered items (col. 9, lines 24-40 – note the second user may accept or reject matches which include alternative and approximate matches);
- receiving (7) a replacing offer (250) related to said second bartering party (Fig. 4 and col. 9, lines 35-58 – note that after the user rejects a match, further searching is done, i.e. the system finds another match/offer to present to user);
- presenting (8) an offer to accept (160) to said second bartering party (col. 9, lines 19-50); and
- receiving (8) an offer acceptance (260) originating from said second bartering party (Fig. 4 and col. 9, line 58 through col. 10, line 9).

Referring to claim 35, Moore discloses a method according to claim 32, wherein said step of processing (4) a received offer (230) further comprises the steps of:

- receiving data representing an item or items rejected from an offer (130) created by said programmable device (100) (col. 9, lines 24-38 – note the data representing an item rejected is the declining of the match to Jamaica);
- computing a replacing offer based on said data representing said rejected item or items, said first and second sets of preference data (120, 220) and said items (110) available to

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said first party for bartering at said first programmable device (Fig. 4 and col. 9, lines 38-40 – note that if the item is rejected, the process repeats to search for another match based on items available); and

- presenting said replacing offer to said second bartering party (col. 9, lines 19-24, 33-35 and 47-50).

Referring to claim 39, Moore further discloses the method according to claim 32 wherein said step of presenting a first offer to said second bartering party comprises the steps of:

- presenting a first offer (130) to said second bartering party, which offer contains one item (col. 9, lines 19-50);
- receiving an acceptance (260) or rejection of said first offer from said second bartering party (200) (col. 9, lines 24-40); and
- presenting another offer to said second bartering party (200), which offer contains one item (Fig. 4 and col. 9, lines 19-50 - note that if the offer is rejected, the process repeats and other offer(s) are presented).

Claims 41, 44, 48, 52, 53 and 57-59, all of the limitations in apparatus claims 41, 44, 48, 52, 53 and 57-59 are closely parallel to the limitations of method claims 32, 35 and 39, analyzed above and are rejected on the same bases (see also Moore, Fig. 1, col. 4, lines 10-46 and col. 5, line 34 through col. 6, line 29).

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Referring to claims 50 and 60, Moore further discloses the device according to claim 41 and claim 52 wherein said device is connected to a wireless network (Fig. 1 and col. 5, lines 34-59).

Referring to claims 51, 55 and 56, Moore teaches the device according to claim 41 further comprising means arranged to send, receive and store said bartering items on the first device (col. 5, lines 13-25 and col. 6, lines 14-29).

Referring to claim 54, Moore further discloses a system according to claim 52 wherein said first and second bartering devices (100, 200) are both arranged on the same physical unit (col. 5, line 60 through col. 6, line 25 – note the physical unit is the system).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 33, 34, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Elias, US 2001/0034694 A1 (hereafter referred to as "Elias").**

Referring to claim 33, Moore teaches a method according to claim 32, but does not teach the method further comprising a step of automatically valuing an unranked item or group of items based at least on items (110) available to said first bartering party and/or based on preference data (120) of previously valued items or group of items. Elias teaches a system and method for an online marketplace whereby items can be bartered including automatically valuing an unranked item based at least on items available to a first bartering party or based on preference data of previously valued items or group of items (e.g. Fig. 4 and ¶¶0060-0064).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Moore the ability to automatically value an item based on items available to parties or on previous valued items, as taught by Elias, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that results of the combination were predictable.

Referring to claim 34, Moore teaches the method according to claim 32, but does not teach wherein said step of processing (4) said received offer (230) further comprises the steps of:

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valuating said received offer in accordance with input data (120) from said first bartering party; valuating said received offer in accordance with input data (220) from said second bartering party; presenting said valuations to said first bartering party. Elias teaches a system and method for an online marketplace whereby items can be bartered including valuating a received offer in accordance with input data from a first bartering party, valuating a received offer in accordance with input data from a second bartering party and presenting said valuations to said first bartering party (e.g. ¶¶0060-0064 – note the valuations of the offer are the appraisal values of the items that are offered and presented to users and used to evaluate offers).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Moore the abilities to value a received offer in accordance with input data from a first bartering party, value a received offer in accordance with input data from a second bartering party and presenting said valuations to said first bartering party, as taught by Elias, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that results of the combination were predictable.

Referring to claims 42 and 43, all of the limitations in apparatus claims 42 and 43 are closely parallel to the limitations of method claims 34 and 35, analyzed above and are rejected on the same bases (see also Moore, Fig. 1, col. 4, lines 10-46 and col. 5, line 34 through col. 6, line 29).

**Claims 36 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Mahanti et al., US 2002/0052824 A1 (hereafter referred to as "Mahanti").**

Referring to claim 36, Moore teaches a method according to claim 32, wherein said step of processing (4) a received offer (230) comprises the steps of presenting said received offer for said first bartering party (col. 9, lines 19-24, 33-35 and 47-50), but does not teach the method further comprising the steps of allowing said first bartering party to create a replacing offer, by altering said received offer and presenting said replacing offer to said second bartering party. Mahanti teaches a method and system for performing automated negotiation for electronic trading including allowing a first bartering party to create a replacing offer by altering a received offer and presenting the replacing offer to a second bartering party (Fig. 20 and ¶0144).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Moore the abilities to allow a first bartering party to create a replacing offer by altering a received offer and present the replacing offer to a second bartering party, as taught by Mahanti, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that results of the combination were predictable.

Referring to claim 45, all of the limitations in apparatus claim 45 are closely parallel to the limitations of method claim 36, analyzed above and are rejected on the same bases (see also Moore, Fig. 1, col. 4, lines 10-46 and col. 5, line 34 through col. 6, line 29).



**Claims 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Mahanti as applied to claim 36, and further in view of Elias.**

Referring to claim 37, Moore in view of Mahanti teaches the method according to claim 36, but does not teach the method further comprising the steps of: valuating said replacing offer in accordance with input data from said first bartering party (120); valuating said replacing offer in accordance with input data from said second bartering party (220); and presenting said valuations to said first bartering party. Elias teaches a system and method for an online marketplace whereby items can be bartered including valuating an offer in accordance with input data from a first bartering party, valuating an offer in accordance with input data from a second bartering party and presenting said valuations to said first bartering party (e.g. ¶¶0060-0064 – note the valuations of the offer are the appraisal values of the items that are offered and presented to users and used to evaluate offers).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Moore/Mahanti the abilities to valuate a replacing offer in accordance with input data from a first bartering party, valuate a replacing offer in accordance with input data from a second bartering party and present said valuations to said first bartering party, as taught by Elias, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that results of the combination were predictable.

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Referring to claim 46, all of the limitations in apparatus claim 46 are closely parallel to the limitations of method claim 37, analyzed above and are rejected on the same bases (see also Moore, Fig. 1, col. 4, lines 10-46 and col. 5, line 34 through col. 6, line 29).

**Claims 38 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore/Mahanti/Elias as applied to claim 37, and further in view of Guo et al., US 2003/0204466 A1 (hereafter referred to as “Guo”).**

Referring to claim 38, Moore/Mahanti/Elias teaches the method according to claim 37, but does not teach the method further comprising the steps of: computing a recommended alteration of said offer based on said received offer (230) and said computed (130) offer and said rejected items and presenting said recommended alteration to said first bartering party. Guo teaches a system and method for performing a negotiation on a computer network including computing a recommended alteration of an offer based on a received offer and a computed offer and rejected items and presenting the recommended alteration to a first bartering party (Figs. 5, 7 and 8 and ¶¶0013, 0047, 0051, 0053 and 0066).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Moore/Mahanti/Elias the abilities of computing a recommended alteration of an offer based on a received offer and a computed offer and rejected items and presenting the recommended alteration to a first bartering party, as taught by Guo, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one

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of ordinary skill in the art would have recognized that results of the combination were predictable.

Referring to claim 47, all of the limitations in apparatus claim 47 are closely parallel to the limitations of method claim 38, analyzed above and are rejected on the same bases (see also Moore, Fig. 1, col. 4, lines 10-46 and col. 5, line 34 through col. 6, line 29).

**Claims 40 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Weber et al., US 2003/0236843 A1 (hereafter referred to as “Weber”).**

Referring to claim 40, Moore teaches the method according to claim 32, but does not teach the method further comprising the step of accessing items in accordance with Digital Rights Management regulations at said first device (100). Weber teaches a system and method for receiving digital content including accessing items in accordance with digital rights management regulations at a first device (e.g. ¶0025).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to include in the commerce method of Moore the ability to access items in accordance with digital rights management regulations at a first device, as taught by Weber, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that results of the combination were predictable.

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Referring to claim 49, all of the limitations in apparatus claim 49 are closely parallel to the limitations of method claim 39, analyzed above and are rejected on the same bases (see also Moore, Fig. 1, col. 4, lines 10-46 and col. 5, line 34 through col. 6, line 29).

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Silverman et al., US 2006/0026077 A1, discloses a system and method for bartering items including receiving preference data from customers, matching the data, and facilitating negotiations and trading of items (see, e.g., Abstract and pages 1-7);
2. Carothers et al., US 2002/0069117 A1, discloses a peer-to-peer electronic marketplace systems and methods for conducting transactions including facilitating in trading of items between users and negotiations (see, e.g., Abstract and pages 1-8);
3. Peppel, US 6,200,216 B1, discloses a system for trading electronic trading cards including receiving preference data, storing the bartering items on a first device, and facilitating in negotiating and trading of cards (see, e.g., Abstract and columns 1-12); and
4. Lu, US 2005/0251453 A1, discloses a system and method for online trading of electronic media (see, e.g., Abstract and pages 1-3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116.

The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amee A Shah/  
Primary Examiner, Art Unit 3625

AAS  
May 26, 2010